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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,074	05/21/2007	Christian Funke	2400.0380000/VLC/CMB	3350

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EXAMINER	
PIHONAK, SARAH	

ART UNIT	PAPER NUMBER
1627	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/579,074	FUNKE ET AL.	
	Examiner	Art Unit	
	SARAH PIHONAK	1627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,6 and 7* is/are pending in the application.

4a) Of the above claim(s) *6 and 7* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/27/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This application, filed on 5/21/2007, is a national stage entry of PCT/EP04/12328, filed on 10/30/2004.

Priority

This application claims foreign priority to the following applications: 10353278.1, filed on 11/14/2003; and 102004006075.4, filed on 2/7/2004. Certified English language translations have been received for the foreign priority documents, and acknowledgement is made of the claim to the foreign priority date of 11/14/2003.

Declaration under 37 CFR § 1.132

1. The declaration under 37 CFR 1.132 filed 10/27/2009 is insufficient to overcome the rejection of claims 1-2 and 4-5 based upon 35 USC § 103(a) as being unpatentable over WO 03/015518 publication, in view of Ohkawara et. al., British Crop Protection Council Conference-Pests and Diseases, 1, pp. 51-58, and Blumel et. al., J. Appl. Ent., 125, pp. 201-205, and Colby, Weeds, pp. 20-22 as set forth in the last Office action because the claims are not commensurate in scope with the data provided by the declaration and specification. The claims are drawn to a composition comprised of a synergistically effective amount of a compound (I) selected from Ia, Ie, Ig, Ih, Ii, Ik, Il, or Im, and a compound of formula (II-1), in which the ratio of the compounds of formula (I) and a compound of formula (II) ranges from 250:1 to 1:50. The declaration shows a synergistic combination between several compounds of formula (II), and compounds (Ik), Im, and Ia, at ratios of 1:25, 1:1, and 10:1. The claims are broader in scope than the results provided by the declaration, in that the claims are also drawn to a synergistic

combination between compounds of formula (II) and compounds Ie, Ig, Ih, Il. The specification and declaration do not show data for a synergistic combination between compounds of formula (II) and Ie, Ig, Ih, or Il. Additionally, the specification and declaration show a synergistic combination for ratios of formula (II) to compounds Ik, Im, and Ia of 1:25, 1:1, and 10:1; however, the claimed ratio range is considerably broader. As such, the declaration is not fully commensurate in scope with the claims, and is not sufficient to overcome the rejection of claims 1-2 and 4-5 under 35 USC § 103(a). Claims 2, 4, and 5 have been cancelled by the Applicants, and the rejection of these claims is considered moot.

Response to Remarks

2. Applicant's arguments filed 10/27/2009 have been fully considered but they are not persuasive. The Applicants have argued that the WO 03/15518 publication discloses many different compounds, and there is no teaching or suggestion to combine the elected compound of formula (II), 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide with the elected species of formula I, clothianidin (compound Im). The examiner disagrees, as the WO 03/15518 publication teaches a pesticide composition comprised of the compound, 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide, and teaches that compounds of formula II, which includes the elected compound, can be combined with agents, including clothianidin, to broaden pesticidal activity. As such, it would have been obvious to one

of ordinary skill in the art to prepare a composition comprised of 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide and clothianidin.

The Applicants have argued that neither the WO '518 publication nor Ohkawara et. al. indicates that the claimed compounds may be combined to provide a synergistic combination. As discussed supra, the WO '518 publication teaches that 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide and clothianidin can be combined to provide broader spectrum pesticide activity. Ohkawara et. al. teaches that clothianidin is an effective pesticide with low toxicity to plants, and Blumel teaches that synergistic combinations of pesticides can result by mixing pesticides with different mechanisms of action. As such, it would have been obvious to prepare a synergistic pesticidal composition comprised of clothianidin and 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide, in view of the prior art. However, in further consideration of the claims, a new rejection has been made, which will be discussed in detail further in this office action. Accordingly, this action is made **NON-FINAL**.

Claims 6 and 7 were previously withdrawn due to the restriction requirement.

3. Claim 1 was examined.

4. Claim 1 is rejected.

Claim Rejections-35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lahm et. al., WO 2003/015518 publication, in view of Angst et. al., WO 2002/37964 publication. The reference of Lahm et. al. was discussed in the previous office action dated 4/27/2009, and was presented on the Information Disclosure Statement.

Claim 1 is drawn to a composition comprised of a synergistically effective amount of a compound of formula (I), such as the elected compound clothianidin (Im), and the elected compound of formula (II), 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide, in which the ratio of clothianidin and 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide ranges from 250:1 to 1:50.

Lahm et. al. teaches a method of controlling pests by application of a compound of formula I, including the elected compound, 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide (Abstract; p. 2, lines 5-26; p. 3, lines 1-19; p. 42, Example 11), in a mixture with acceptable carriers or diluents (p. 89, lines 1-4). Lahm et. al. also teaches that compounds of formula I, such as 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide, can be combined with at least one additional biologically active compound, to provide broader spectrum pesticide activity (p. 10, lines 24-27; p. 96, lines 23-28). Particularly, it is taught that preferred compounds for preparing mixtures with compounds of formula (II) include neonicotinoid compounds such as clothianidin (p. 97, line 37-p. 98, line 2; p. 141, claim 6 and 9). Lahm et. al. teaches that compounds such as 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide exhibit activity towards a broad variety of pests (p. 91, line 32-p. 96, line 22).

While Lahm et. al. teaches that 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide is mixed preferably with clothianidin for broader spectrum pesticide activity, it is not explicitly taught that the combination is synergistic, or that the ratio range for clothianidin to 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide ranges from 250:1 to 1:50.

Angst et. al. teaches a composition for controlling pests which comprises a compound of formula (A) and additional compounds, including clothianidin (Abstract; p. 1, 3rd paragraph; p. 2, right column, 5th compound from bottom; p. 23, claim 1). It is taught that the composition comprised of compounds of formula (A) and clothianidin results in a synergistic pesticide (p. 7, 2nd and 3rd paragraphs), and that the mixing ratio for compounds of formula (A) to clothianidin ranges from 100:1 to 1:6000 (p. 7, 1st paragraph). Angst et. al. teaches that the synergistic combination is effective in protecting a broad variety of crops (p. 11, 2nd full paragraph), and that the combination of compound of formula (A) with clothianidin is less phytotoxic than either agent alone (p. 7, last paragraph).

One of ordinary skill in the art would have been motivated, at the time of the invention, to prepare a synergistic pesticide composition comprised of clothianidin and 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide, in a ratio range between 250:1 to 1:50, because Lahm et. al. teaches that 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide is

preferably combined with neonicotinoids such as clothianidin for increased pesticide action, and Angst et. al. teaches that compositions comprised of clothianidin and other pesticide agents results in a synergistic combination. As the compounds of formula (A) taught by Angst and 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide are both pesticides, and are taught to be effective for protecting a variety of crops, it would have been prima facie obvious for one of ordinary skill in the art to substitute 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide for compounds of formula (A) in the composition taught by Angst. Particularly, Lahm et. al. teaches that preferred combinations include compounds of formula (II) such as 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide and clothianidin. Therefore, as it is taught that 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide is preferably combined with clothianidin, and Angst et. al. teaches that compositions comprised of clothianidin and other neonicotinoid compounds provide synergistic pesticide action, one of ordinary skill in the art would have expected that combining 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide with clothianidin would also have provided a synergistic pesticide effect. Angst et. al. teaches that the ratio ranges of clothianidin to compounds of formula (A) are between 6000:1 to 1:100. As it would have been obvious to substitute 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide for

compounds of formula (A) in this composition, it would have been obvious to prepare a mixture of clothianidin and 3-bromo-N-[4-chloro-2-methyl-6-{(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide between a ratio range from 6000:1 to 1:100, which is includes the claimed range.

Information Disclosure Statement

9. The information disclosure statement (IDS) submitted on 10/27/2009 was filed after the mailing date of the non-final action on 4/27/2009. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARAH PIHONAK whose telephone number is (571)270-7710. The examiner can normally be reached on Monday-every other Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.P.

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1627